IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 2492
	)	
Naoyuki Sato	)	
	)	Examiner: Chea, Philip J.
Serial No.: 10/658,057	)	
	)	
Filed: September 8, 2003	)	**REPLY BRIEF IN RESPONSE TO**
	)	**EXAMINER'S ANSWER**
For: **METHOD OF AND APPARATUS**	)	
FOR PROVIDING LOCALIZED	)	
INFORMATION FROM AN	)	162 N. Wolfe Rd.
INTERNET SERVER OR	)	Sunnyvale, CA 94086
PORTAL TO USER WITHOUT	)	(408) 530-9700
REQUIRING USER TO ENTER	)	
LOCATION	)	
	)	Customer No. 28960

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed on February 2, 2011, this Reply Brief is hereby submitted. Claims 1-7, 9-33 and 35-41 have been rejected. The Appellant submits this brief to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.41, as stated in *Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule)*, 69 Fed. Reg. 49959 (August 12, 2004).

The Appellant contends that the rejection of Claims 1-7, 9-33 and 35-41 in this pending application is in error and should be overcome by this appeal. The appellant further contends that the Stewart, Brauel and Hannah references do not support the rejection of Claims 1-7, 9-33 and 35-41.

I.   **SUMMARY OF THE CLAIMED INVENTION**

The invention disclosed in the present application number 10/658,057 is directed to methods and apparatuses for providing localized information from an internet server or portal to a user without requiring the user to enter their location information. The method and apparatus preferably maintain a location table of the IP addresses for wireless access points and the location information for the access point. When a user accesses a portal through a wireless access point to obtain localized information, the portal then determines, using the IP address for the wireless access point and the location table, the location information corresponding to that wireless access point. The portal then provides the localized information to the user for their location based on the location information obtained from the location table without requiring the user to know or enter the location information. In an alternative embodiment, the location information is maintained at the wireless access point and automatically provided to the portal from the wireless access point.

II.   **ARGUMENTS RELATED TO REJECTION OF CLAIMS 1-7, 9-33 and 35-41**

A.   **Teachings of Stewart, Brauel and Hannah**

Stewart teaches a system and method for enabling a business to register a domain location to provide location based services to on-site customers. Specifically, Stewart teaches a domain place registry 150 where physical domain name information is stored and a domain place registration web site 190 which a business 160 accesses to register a domain location and to specify desirable known geographic location ("KGL") services to be available at the location. The known geographic location (KGL) services or localized information is obtained by the system through the specification of the localized information by businesses on the domain place registry. [Stewart, ¶¶ 0037, 0047, 0048, 0054] However, Stewart does not teach a method of generating a location table corresponding to the network address and location of access points upon an *initial* communication from each of the access points. Indeed, as recognized within the Examiner's Answer, Stewart is not used to teach this limitation. Further, Stewart does not teach that the localized information corresponding to a physical location of a specific access point ... is defined by the internet portal according to the physical location, independent of an identification of the specific access point. Instead, Stewart teaches that a business/user registers a domain and specifies/defines localized information, not that the localized information is defined by the internet portal. Within the Examiner's Answer, it is asserted that Stewart teaches localized

information. [Examiner's Answer, page 6] However, a mere teaching of the concept of localized information, is not the same as teaching that the localized information is defined by the internet portal that is being accessed. Thus, even if Stewart is only asserted as teaching the "localized information" portion of the above-cited limitation, Stewart still fails to teach localized information defined by an internet portal according to a physical location. Accordingly, Stewart does not teach the presently claimed invention.

Brauel teaches a communications network including a communication server 102 coupled to a plurality of access points 106. Brauel teaches that the plurality of access points 106 are capable of wireless communications with one or more mobile wireless communication devices 120. [Brauel, ¶ 0021] Brauel teaches that the wireless communication devices 120 determine their own location based on information provided by the communication server 102. [Brauel, ¶ 0025] However, Brauel does not teach that the localized information corresponding to a physical location of a specific access point ... is defined by the internet portal according to the physical location, independent of an identification of the specific access point. Indeed, within the Examiner's Answer Brauel is only asserted as teaching that access points are able to be associated with their physical location. [Examiner's Answer, page 6] Thus, Brauel does not contribute to the "defined by the internet portal" aspect or the "independent of the identification of the specific access point" aspect of the above-cited limitation.

Furthermore, Brauel does not teach generating a location table corresponding to the network address and location of access points upon an *initial* communication from each of the access points. Instead, Brauel does not discuss initial or any communication between an access point and the communication server with regard to generating a location table. [See Brauel, ¶ 0025] Within the Examiner's Answer, it is acknowledged that Brauel does not teach that the location table is generated "upon an initial communication from each of the access points," but it is asserted that it would have been obvious because the network administrator could generate the location table at the same time as each access point is assigned an address. [Examiner's Answer, pages 7-8] However, no citation is provided and nowhere does Brauel teach, suggest or even hint that the location table could beneficially be generated upon an initial communication or at the same time as an address is assigned to an access point. In particular, Brauel is completely silent upon the timing of the generation of a location table. Indeed, even if Brauel taught that the location table could be generated at the same time as the assigning of the addresses, nowhere does Brauel teach that said assigning takes place upon an initial communication either. [See Brauel, ¶ 0024] In sum, a mere general teaching of the creation of a location table (without any

reference to a time of creation) cannot make obvious that the table is created upon an initial communication or at any particular time. There are many alternate times at which a location table can be generated, and thus sufficient motivation must be provided to make obvious the choice of any one particular time. Accordingly, in contrast to the assertions within the Examiner's Answer, the general teaching of the creation of a location table in Brauel does not make obvious "generating a location table corresponding to the network address and location of access points *upon an initial* communication from each of the access points." Accordingly, Brauel does not teach the presently claimed invention.

Hannah teaches that wireless network devices can obtain their geographical locations by triangulation with access points that have precise time information. [Hannah, Abstract] In response to a location prompt, a wireless device can send a transmission to multiple access points that are within its range. Specifically, Hannah teaches that the calculation of the location of the mobile device may be performed in various places. In one embodiment, the server receives the ping-reception time from each access point and calculates the location of the mobile device based on the location of each of the access points and the time each ping was received by each access point. Hannah teaches that the data indicating the location of each access point can be transmitted, along with the ping reception time, from the access point to the server after the ping signal is received, or that the location of each access point is contained in a database that is accessible to the server. [Hannah, col. 3, lines 38-50] However, as recognized within the Examiner's Answer, Hannah does not teach a method of generating a location table corresponding to the network address and location of access points upon an initial communication from each of the access points. [Examiner's Answer, page 8]

Further, Hannah does not teach that the localized information corresponding to a physical location of a specific access point ... is defined by the internet portal according to the physical location, independent of an identification of the specific access point. Within the Examiner's Answer it is asserted that because Hannah teaches location info "can be stored from the access point onto a server (see column 2, lines 35-42)," it also teaches "[t]his [storage] can be used to offer localized information independent of the identification of the access point." [Examiner's Answer, page 7] The Appellants respectfully disagree. No citation of Hannah has been made and indeed nowhere does Hannah teach that the server storage can be used to offer localized information independent of the identification of the access point. All that the cited portion of Hannah teaches is:

> In one embodiment, each access point 12-14 stores [its] own location and provides that location information to other devices as needed, such as to server 15 over network 11. In another embodiment, the location of each access point may be contained in a database that is stored in a more central location, such as at server 15. The location information may be stored in any useful format. [Hannah, col. 2, lines 35-42]

Thus, the cited portion of Hannah teaches nothing regarding localized information ... defined by the internet portal according to the physical location, independent of an identification of the specific access point. Again, more is required than a mere general teaching the location information can be stored on a server in order to teach or make obvious the above-cited limitation. Instead, Hannah merely teaches "[c]ommon triangulation techniques may then be used to determine the location of the mobile device with respect to those access points," and that each access point stores its own location and provides that location information to other devices such as a server. [Hannah, col. 2, lines 31-39] Therefore, it is clear that Hannah still does not teach localized information corresponding to the location information is defined by the internet portal, independent of an identification of the access point. Accordingly, Hannah does not teach the presently claimed invention.

B.   The combination of Stewart, Brauel and Hannah does not teach the presently claimed invention and is improper.

Each of the Applicant's independent claims specifies either that 1) the localized information corresponding to the location information is defined by the internet portal, independent of an identification of the access point or 2) generating an entry in the location table upon receiving an *initial* communication from an access point. As a result, as described above, because neither Stewart, Brauel, Hannah nor their combination teach defining the localized information by the internet server/portal, the localized information is determined according to the physical location information and independent of an identification of the access point, or generating an entry in a location table upon receiving an *initial* communication from an access point, neither can their combination. Accordingly, neither Stewart, Brauel, Hannah nor their combination teach the claims of the presently claimed invention.

Furthermore, as discussed above, within the Examiner's Answer it is asserted that the localized information is taught by Stewart, and that Hannah teaches that the location information can be stored from the access point onto a server. [Examiner's Answer, pages 6-7] It is then concluded that "[t]his can be used to offer localized information independent of the identification of the access point because the information about the access point has already been stored

previously." [Examiner's Answer, page 7] The Appellant respectfully disagrees. Functionality has inappropriately been attributed to the system of Stewart that is not taught by Stewart, and only by relying on this incorrectly attributed functionality is the asserted system of Stewart in view of Brauel in further view of Hannah able to be asserted as teaching the presently claimed invention. Specifically, hindsight is being relied on in view of the present claims, to modify Stewart such that it allegedly teaches to offer localized information independent of the identification of the access point, which it does not.

In particular, within the Office Action of June 14, 2010, Brauel is cited for teaching a location table that includes entries each having a network address and physical location information. However, it is Stewart that is relied upon for teaching obtaining location information corresponding to the network address from a location table, wherein the location information is determined at an internet portal based on the location table, obtaining the localized information from a localized information database using the location information, and providing the localized information to the user through the access point. [Office Action of June 14, 2010, pages 2-4] As such, it is the functionality of Stewart that is to be modified with the teachings of Hannah so as to provide localized information based on the physical location of a specific access point accessing an internet site, independent of an identification of the specific access point. However, the teachings of Hannah are directed to similar functionality as is already disclosed in Stewart. Specifically, Stewart teaches in paragraph 0084:

> KGL information of the business or customer may be determined by the system, such as by transmission of the KGL by the AP 120, transmission of GPS information by the customer's PCD 110, *or* by transmission of an identifying ID, such as a MAC ID, of the AP 120, which the system may use to look up the KGL information from a database. (Emphasis added)

In other words, Stewart explicitly teaches that it is <u>either</u> the MAC ID of the AP 120 <u>or</u> the GPS information transmitted by the PCD 110, <u>but not both</u>. Contrarily, the presently claimed limitations advantageously disclose the use of <u>both</u> a network address and location information through the use of a location table. Using a location table to link both pieces of information eliminates the need for additional equipment (such as the GPS equipment) and/or processing (such as the triangulation method of Hannah) to determine the physical location information, which is subsequently used to determine the localized information.

Accordingly, there is no motivation for the adding of the triangulating method of Hannah to the asserted system of Stewart in view of Brauel as it does not add functionality to the GPS information already disclosed in Stewart, and Stewart already discloses that the GPS information is used as an alternative for the MAC ID. The teachings of Hannah do not change this. As such, whether it is the asserted system of Stewart in view of Brauel or the asserted system of Stewart in view of Brauel in further view of Hannah, the asserted system fails to teach an inclusive three step sequence of 1) determining a network address, 2) using a location table to obtain location information according to the network address, and 3) obtaining localized information using the location information. The present claims are directed to using both the network address of the access point and the location information of the access point, obtained using the location table, to obtain localized information. The system of Stewart, whether combined with Brauel or with Brauel and Hannah, specifically teaches one or the other, but not both the network address and the location information of the access point. It is only through hindsight of the presently claimed invention that there is motivation for using both the network address and the physical location of the access point to obtain localized information for a user.

Within the Examiner's Answer, it is asserted that Brauel teaches a location table and physical attributes of an access point, and thus the use of both a network address and a physical location to obtain localized information "is an obvious extension that could be added to the system of Stewart." [Examiner's Answer, page 9] However, no citation of Stewart or Brauel is made within the Examiner's Answer that supplies any motivation for the use of both a network address and a physical location. Instead, the Examiner's Answer simply concludes that one of ordinary skill in the art would have found it advantageous to relate a network address to a physical location of an access point to provides location based servers depending on the physical location of the access point. [Examiner's Answer, page 9] As described above, such a conclusion is the result of hindsight bias and not warranted based on the cited prior art. Again, where the Stewart teaching of using the MAC ID is used, the asserted combination fails to teach "localized information corresponding to the location information is defined by the internet portal, independent of an identification of the access point." Where the Stewart teaching of using the GPS information is used, the asserted combination fails to teach "obtaining location information corresponding to the network address." Nowhere is there any motivation or suggestion of the beneficial combination of a network address and a physical address to obtain localized information for a user. Thus, the combination of Stewart, Brauel and Hannah is improper because it lacks sufficient motivation.

Also within the Examiner's Answer, it is asserted that the combination of Stewart with Brauel and Hannah is proper because "Stewart was merely used to teach that is it desirable to provide location information to portable devices in case they might want to receive sale information about stores that are nearby, ... [thus, it would have been obvious] to modify the inner workings of Stewart using the teachings of Brauel and Hannah and could still provide the location information." [Examiner's Answer, page 7]   Appellants respectfully disagree. The MPEP states, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." W.L. Gore & Associates, Inc. v. Garlock, Inc. 721 F.2d 1540 (Fed. Cir. 1983); MPEP § 2141.02 (VI). In light of this requirement of the MPEP, it is clearly improper to combine Brauel with Stewart when, as described above, Stewart teaches away from the claimed invention. Again, Stewart specifically teaches transmitting either GPS information or MAC address information, but not both. Thus, Stewart teaches away from a combination that requires the use of both. However, even if Stewart did not teach away from using both GPS information and MAC address information, the combination would still be improper because it would necessarily change Stewart's principal mode of operation. The MPEP states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." In re Ratti, 270 F.2d 810, 123 (CCPA 1959); MPEP §2143.01. In this case, as described above, Stewart's principal mode of operation only involves either GPS information or MAC address information, but not both. As a result, it is evident combining Stewart with Brauel and Hannah such that Stewart uses both would change Stewart's principal operation. Thus, in any circumstance the combination of Stewart, Brauel and Hannah will be improper.

The independent Claim 1 is directed to a method of providing localized information to a user accessing an internet site through an access point. The method of Claim 1 comprises determining a network address corresponding to the access point, obtaining location information corresponding to the network address from a location table, wherein the location information is determined at an internet portal based on the location table, obtaining the localized information from a localized information database using the location information, wherein the localized information corresponding to the location information is defined by the internet portal, independent of an identification of the access point, and providing the localized information to the user through the access point. As described above, neither Stewart, Brauel, Hannah nor their

combination teach defining localized information by the internet server/portal, the localized information being determined according to the physical location information and independent of an identification of the access point. For at least these reasons, the independent Claim 1 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 2-7 are all dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 2-7 are all also allowable as being dependent on an allowable base claim.

The independent Claim 9 is directed to a method of generating a location table corresponding to locations of access points. The method of Claim 9 comprises obtaining a network address of one of the access points upon receiving an initial communication from one of the access points, obtaining location information corresponding to a physical location of one of the access points, wherein the physical location is determined at an internet portal, generating an entry within the location table including the network address and the location information and repeating the above upon an initial communication from each of the access points. As described above, neither Stewart, Brauel, Hannah nor their combination teach a method of generating an entry in a location table upon receiving an initial communication from an access point. For at least these reasons, the independent Claim 9 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 10-13 are dependent on the independent Claim 9. As described above, the independent Claim 9 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 10-13 are all also allowable as being dependent on an allowable base claim.

The independent Claim 14 is directed to an apparatus to provide an internet site and capable of being accessed through an access point. The apparatus of Claim 14 comprises a location table including a plurality of entries each having a network address and location information corresponding to the access point, a localized information database coupled to the location table to provide localized information based on the location information, and a controller coupled to the location table and the localized information database for determining the location information of a specific access point based on the location table and for determining the localized information corresponding to the location information of the specific access point, the localized information determined independent of an identification of the specific access point. As described above, neither Stewart, Brauel, Hannah nor their combination teach defining

localized information by the internet server/portal, the localized information being determined according to the physical location information and independent of an identification of the access point. For at least these reasons, the independent Claim 14 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 15-20 are all dependent on the independent Claim 14. As described above, the independent Claim 14 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 15-20 are all also allowable as being dependent on an allowable base claim.

The independent Claim 21 is directed to an apparatus for providing an internet site and capable of being accessed through an access point. The apparatus of Claim 21 comprises a first means for maintaining a location table including a plurality of entries, each entry having a network address and location information corresponding to a specific access point, a second means for maintaining a localized information database coupled to the first means for maintaining and for providing localized information based on the location information, and a controlling means coupled to the location table and the localized information database for determining the location information of a specific access point based on the location table and for determining the localized information corresponding to the location information of the specific access point, the localized information determined independent of an identification of the specific access point. As described above, neither Stewart, Brauel, Hannah nor their combination teach defining localized information by the internet server/portal, the localized information being determined according to the physical location information and independent of an identification of the access point. For at least these reasons, the independent Claim 21 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 22-27 are all dependent on the independent Claim 21. As described above, the independent Claim 21 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 22-27 are all also allowable as being dependent on an allowable base claim.

The independent Claim 28 is directed to an internet server for providing localized information from a localized information database to users through an access point. The internet site of Claim 28 comprises a location table maintained by the internet site comprising a plurality of entries, each entry including a network address corresponding to the access point, and location information corresponding to the access point, and a controller associated with the internet site for determining location information based on the location table, wherein localized information

corresponding to location information of a specific access point accessing the internet site is defined by the internet server according to the location information, independent of an identification of the specific access point. As described above, neither Stewart, Brauel, Hannah nor their combination teach defining localized information by the internet server/portal, the localized information being determined according to the physical location information and independent of an identification of the access point. For at least these reasons, the independent Claim 28 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 29-32 are dependent on the independent Claim 28. As described above, the independent Claim 28 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 29-32 are all also allowable as being dependent on an allowable base claim.

The independent Claim 33 is directed to a network of devices. The network of Claim 33 comprises one or more access points to provide access to an internet site, one or more internet access systems, each capable of communicating with the one or more access points to access the internet site through one of the access points, an apparatus to provide the internet site and capable of being accessed through the one or more access points comprising a location table including a plurality of entries each having a network address and physical location information corresponding to an appropriate one of the access points, and a localized information database coupled to the location table to provide localized information based on the physical location information, wherein localized information corresponding to a physical location of a specific access point accessing the internet site is defined by the apparatus according to the physical location, independent of an identification of the specific access point, wherein the physical location information is determined at the apparatus based on the location table. As described above, neither Stewart, Brauel, Hannah nor their combination teach defining localized information by the internet server/portal, the localized information being determined according to the physical location information and independent of an identification of the access point. For at least these reasons, the independent Claim 33 is allowable over the teachings of Stewart, Brauel, Hannah and their combination.

Claims 35-41 are all dependent on the independent Claim 33. As described above, the independent Claim 33 is allowable over the teachings of Stewart, Brauel, Hannah and their combination. Accordingly, Claims 35-41 are all also allowable as being dependent on an allowable base claim.

III.   CONCLUSION

Accordingly, it is respectfully submitted that Claims 1-7, 9-33 and 35-41 are allowable over the teachings of Stewart, Brauel, Hannah and their combination. Therefore, a favorable indication is respectfully requested.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: March 21, 2011   By: /Jonathan O. Owens/
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